

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Scheller, D.
Serial No.: 10/593.964
Filed: September 22, 2006
Title: USE OF ROTIGOTINE FOR TREATING AND PREVENTING
PARKINSON'S PLUS SYNDROME
Group Art Unit: 1614
Examiner: S. Javanmard
Confirmation No.: 4037
Docket No.: 6102-000048/US/NP
Client Ref.: P/Sche/6/04

SUBMITTED ELECTRONICALLY VIA EFS-WEB

May 15, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Examiner Javanmard:

RESPONSE TO OFFICE ACTION DATED APRIL 20, 2009

This paper is responsive to the Office Action dated April 20, 2009 in the above referenced application, in which a shortened statutory period of one month was set for reply. This response is timely and no fee for extension of time is believed payable. If any fee should be found payable in respect of this submission, authorization is hereby provided to charge the amount of such fee to Deposit Account No. 08-0750.

1. Restriction Requirement

By the present Action, Applicant is required under 35 U.S.C. §121 and §372 to restrict the application to one of the following groups:

- I. Claims 8–24 (not 1–24 as indicated in the Action; Claims 1–7 are canceled):
method for prevention and/or treatment of Parkinson's plus syndrome;
- II. Claims 25–30: therapeutic combination comprising rotigotine and a further active
substance that prevents or reduces rate of progression of dopaminergic cell loss;

- III. Claim 31: kit for treatment and/or prevention of Parkinson's plus syndrome, comprising a first medicinal preparation comprising rotigotine and a second medicinal preparation comprising a further active substance that prevents or reduces rate of progression of dopaminergic cell loss.

Applicant respectfully traverses the requirement for restriction between Groups II and III, on the ground that kit Claim 31 of Group III can be seen to represent an embodiment of the therapeutic combination of Claim 25 in Group II, and could have been written in dependent form. It is respectfully suggested that Group II be redefined to encompass Claims 25–31. Applicant does not traverse the requirement for restriction between Group I on the one hand and Groups II and III on the other hand.

Applicant provisionally elects Group I for examination on the merits.

In relation to the statement in the present Action (p. 3) that U.S. Patent Application Publication No. 2003/0027793 (herein "Lauterbach") teaches use of rotigotine to treat Parkinson's disease, it is noted for the record that Parkinson's plus syndrome is not the same thing as Parkinson's disease. See, for example, the distinctions summarized in Table 1 (p. 2 of the present specification).

2. Requirement for Election of Species

By the present Action, Applicant is further required to elect a single disclosed species within the elected Group I. Applicant provisionally elects with traverse rotigotine as the species of compound, and minocycline as the species of further active agent (with respect to Claims 22–24 only).

The present election requirement is traversed on the following grounds.

1. The genus of rotigotine, physiologically acceptable salts of rotigotine, and rotigotine prodrugs is small enough not to pose an undue search burden on the Office.
2. The further active agent for prevention and/or treatment of Parkinson's plus syndrome (recited in Claims 22–24 only), when searched in conjunction with rotigotine, physiologically acceptable salts of rotigotine, and rotigotine prodrugs, will be found not to impose an undue search burden on the Office.

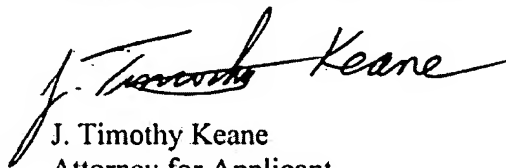
3. The embodiment of greatest interest to Applicant at present comprises administration of rotigotine or a salt or prodrug thereof without requirement for an additional active agent. Thus, requiring Applicant to elect a species of additional active agent focuses initial examination on an embodiment of lesser interest.

At least the following claims are readable on the provisionally elected species of compound: Claims 8-18 and 22-24. The present provisional election of species does not constitute admission that Applicant considers the invention to be limited to such species.

Applicant believes the application is now in condition for examination on the merits. Should any issues remain, the Examiner is invited to call the undersigned at the telephone number given below.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

A handwritten signature in black ink, appearing to read "J. Timothy Keane". The signature is fluid and cursive, with the last name "Keane" being more prominent.

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